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PATENT B Ross

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Applicant : Yukari Hashizume
Serial No. : 10/037,728
Filed : October 19, 2001
Title : BINDER INSERT
Docket : 550718-093
Examiner : Mark T. Henderson
Art Unit : 3722

Assistant Commissioner for Patents
Washington, D.C. 20231

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TECHNOLOGY CENTER R3700

Sir:

RESPONSE

This paper is submitted in response to the Office action mailed on October 3, 2002, having a period of response extending through and including January 3, 2003. Reconsideration of the application is respectfully requested.

Claims 1-16 stand rejected as being unpatentable over U.S. Patent No. 5,301,445 to Hoffmeister in view of U.S. Patent No. 2,568,178 to Widder. This rejection is respectfully traversed for the following reasons.

The Office action recites Hoffmeister as teaching a binder insert comprising a transparent plastic bag-shaped body with an open upper side, a photograph store portion and a memo store portion, a store board and a binding section having a plurality of binding holes. As indicated in

the Office action, Hoffmeister fails to disclose a store board having slits at predetermined locations and slits and in various shapes. The Office action relies on Widder for teaching these missing elements indicates that it would have been obvious to combine the store board having slits as taught by Widder with the binder insert disclosed by Hoffmeister.

Initially, applicants respectfully submit that claim 1 has been misconstrued with respect to the portion of the claim reciting “a color paper therebetween”. This language refers to color paper being positioned between the two sides of the thick paper folded in two and forming the store board. The presence of the colored paper between the two sides of the thick paper forming the store board is a structural feature of the invention as set forth in claim 1 that is neither disclosed nor described in the prior art references cited. Accordingly, applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to claim 1 because the prior art references cited by the examiner considered either individually or in combination fail to disclose each and every element of the claimed structure.

Furthermore, not only do the prior art references fail to disclose the colored paper situated between the folded portions of the thick paper forming the store board, the references also fail to disclose a transparent plastic body having a photograph store portion and a memo store portion and a memo paper to be inserted into the memo store portion. Hoffmeister discloses a memo or margin area adjacent the photograph storage pockets. However, as clearly shown in Figs. 5 and 6, the memo or margin area is an extension of the backing sheet 18 beyond the width of the transparent sheet 24. There is no disclosure of a memo store portion or a memo paper to be inserted therein. Accordingly, the reference fails to disclose or suggest a memo store portion and a memo paper to be inserted into the memo store portion as presently set forth in claim 1. Accordingly, for this reason as well, applicants respectfully submit that the cited references fail to disclose this element of the claimed structure and therefore are insufficient to establish a *prima facie* case of obviousness.

Applicants also maintain that the cited references fail to provide the requisite motivation to combine and modify the cited prior art references.

A determination of obviousness based on a combination of elements disclosed in the prior art must include some reference to a motivation, suggestion or teaching to combine the references. See, e.g., *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q. 2d (BNA) 1635, 1637 (Fed. Cir. 1998). The motivation, suggestion or teaching may come from the prior art, the knowledge of one skilled in the art or from the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q. 2d (BNA) 1614, 1617 (Fed. Cir. 1999). A finding of obviousness without particular findings as to the motivation or suggestion in the prior art for combining the references is an impermissible use of hindsight based on the Applicants' application. *In re Paulsen*, 31 U.S.P.Q. 2d 1671, 1676 (Fed. Cir. 1994) ("Multiple cited prior art references must suggest the desirability of being combined, and the references must be viewed without the benefit of hindsight afforded by the disclosure.").

The Office action indicates that it would have been obvious to combine the teachings of Hoffmeister with that of Widder to teach the invention as claimed. The proposed motivation for combining the references is to provide a method of "mounting the photographs in a stable position on the store board." Applicants respectfully submit that no such motivation to combine the references exists.

Specifically, one of ordinary skill in the art at the time of the present invention would not have been motivated to combine Hoffmeister with Widder to teach the invention as claimed because the references fail to provide any motivation to make the proposed combination. Furthermore, applicants submit that the two references are not properly combinable. One of skill in the art reading the Hoffmeister reference would not be motivated to combine Hoffmeister with Widder's method for mounting photographs in a stable position since this is the exact problem that Hoffmeister addresses. Hoffmeister describes the images as being "retained in a fixed

position with respect to the backing sheet, and are retained against lateral sliding movement and vertical downward movement.” See Column 2, lines 46-50. Therefore, one of ordinary skill in the art would not need to look to other references for a method of mounting the photographs in a stable position on the store board. Furthermore, the mounting methods disclosed in Hoffmeister and Widder rely on significantly different mechanisms for mounting photographs in a stable position such that combining the two would be impractical. Widder discloses a mounting sheet having a plurality of slots designed to engage tabs 25 by photograph mounting pocket 20. The photograph to be mounted is inserted through slot 26 and may be protected by a sheet 23 of transparent material. The mounting pocket can be oriented vertically or horizontally by engaging tabs 25 in either slits 16 or 17. Accordingly, the slits 16 and 17 of the Widder photograph mount engage a photograph mounting pocket 20 as opposed to the photographs themselves. Combining the mounting system of Widder with the album page of Hoffmeister would involve significant modifications of the Hoffmeister structure which would eliminate many of the benefits of the Hoffmeister mounting page. The Hoffmeister design provides a relatively simple and efficient way of displaying images which are retained in a fixed position and centered on the sheet. Widder, on the other hand, requires insertion of the photograph in the storage pocket and engagement of four tabs to hold the mounting pocket in place. One of skill in the art would not consider the mounting device disclosed by Widder as being a viable alternative method for mounting photographs in a stable position in the Hoffmeister album page. Accordingly, applicants respectfully submit that the prior art cited fails to supply the requisite motivation to combine and modify the teachings in the prior art to arrive at the present invention.

With respect to claim 1, as noted above, the recitation of color paper between the thick paper folded in two is a structural difference between the claimed invention and the prior art rather than just a recitation of intended use. Furthermore, this structure is not disclosed in the references cited.

U.S. Serial No. 10/037,728
Attorney Docket No. 550718-093

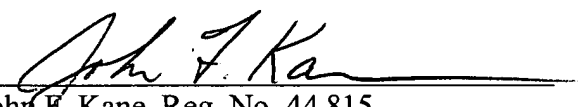
Response

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With respect to claims 6 and 12 which recite color print portions having different colors corresponding to standardized photograph sizes, the Office action indicates that "the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability." Applicants note that the color paper having color print portions is advantageous in that it provides an indication as to the proper slits to use for various size photographs. Furthermore, the presence of the color paper in the store board is advantageous in that it prevents contact between the corners or photographs inserted from each side of the store board.

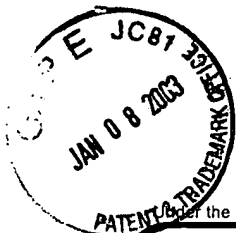
In light of the foregoing response, it is respectfully submitted that claims 1-16, now pending, are patentably distinct from the references cited and are in condition for allowance. Reconsideration and withdrawal of the rejections of record is respectfully requested. If the examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number indicated below.

Respectfully submitted,


John F. Kane, Reg. No. 44,815

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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	10/037,728	
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	First Named Inventor	Yukari Hashizume	
	Group Art Unit	3722	
	Examiner Name	Mark T. Henderson	
Total Number of Pages in This Submission	6	Attorney Docket Number	550718-093

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